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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,851	03/08/2004	Robert C. Angell	12406/5402	2446

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EXAMINER	
SAGER, MARK ALAN	
ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/796,851	ANGELL ET AL.	
	Examiner	Art Unit	
	M. A. Sager	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claim Objections

1. Claim 7 is objected to because of the following informalities: reference '2' line 1. Appropriate correction is required.

Double Patenting

2. Claims 1-35 and 38-43 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6702672. It is reiterated as stated in prior official action that this holding herein is over allowed claims of Alcorn in application 09342150 rather than the incorrect printed claims of 6702672 since those claims do not reflect the claims allowed. The prior holding is maintained for cited claims as amended and reiterated with consideration of amendments below. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to an artisan to omit a feature added in amendment rec'd 6/13/03 defined by claim language 'a microprocessor configured to receive wager information entered by the player, digitally store the identification code, and encrypt the identification code and the player's wager information for transmission, and', (clm 1) and 'a microprocessor configured to receive wager information entered by the player, digitally store the identification code, and encrypt the identification code and the player's wager information for transmission' (clm 21, 28) *where patentability is not dependent thereon* so as to secure a broader form of invention which therefore provides broader patent protection. Essentially, the claim language 'a microprocessor configured to receive wager information entered by the player, digitally store the identification code, and encrypt the identification code and the player's wager information for transmission, and', (clm 1) and 'a microprocessor configured to receive wager information entered by the

player, digitally store the identification code, and encrypt the identification code and the player's wager information for transmission' (clm 21, 28) limited the wireless gaming device and method and thus by omitting the cited language a broader form of invention is secured for broader patent protection where patentability is not dependent thereon. Also, it would have been obvious to an artisan at a time prior to the invention to add 'transmitting the players wager information and identification code in encrypted form' so as to protect form of invention of the wireless device transmitting the data and add a 'processor in communication with the receiver, the processor decrypting the encrypted wager information and identification code received by the receiver' so as to protect the form of invention pertaining to the decryption of the received signal. As evidence only of system transmitting encrypted wager and id code and decrypting same in wireless network, see either Franchi 5770533 or Koza (5069453) or Walker WO96/00950 or Von Kohorn 5697844 or Jonstromer WO96/32700. Also, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Alcorn '672 claims same structure same structure of wireless gaming device, entry apparatus, transmitter,

receiver and processor performing same functions. Further, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.). In this instance, Alcorn '672 claims same structure of wireless gaming device, entry apparatus, transmitter, receiver and processor performing same/similar functions.

3. Claims 36-37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6702672 in view of Jacobsen (5785592). Alcorn '672 claims invention herein (supra) except a security tag, sensing apparatus as claimed. Jacobsen discloses a wireless handheld game device that is used for placing wagers teaching a security tag affixed to or included as part of wireless terminal and a sensing apparatus which activates an alarm when the security tag is passed through the sensing apparatus for increased security to ensure terminal/device does not leave gaming hall. Jacobsen is analogous prior art since Jacobsen is either in the field of applicant's endeavor of wireless wagering handheld device (fig 1-4, ref 20, 96 and description thereof) or, at least is reasonably

pertinent to the particular problem with which the applicant was concerned of improved security by adding electronic tag to device/terminal to alert security if wireless wagering device passes through portal (fig. 4), so as to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Therefore, it would have been obvious to an artisan at a time prior to the invention to add a security tag affixed to or included as part of wireless terminal and a sensing apparatus which activates an alarm when the security tag is passed through the sensing apparatus as taught by Jacobsen to Alcorn '672 for increased security to alert security whenever terminal/device is in process of leaving gaming hall.

Claim Rejections - 35 USC § 103

4. Claims 1-13, 15-35, 38-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodfield (EP 649102) in view of either Franchi (5770533) or Koza (5069453). Woodfield '102 discloses system or method for transmitting wagering information while commanding placing of bets (4:4-15:24, figs. 1-4) comprising a wireless gaming device (11, 21-23) by infrared and further includes local receiver transmitting by radio (figs. 1-3) to system receiver where wireless device includes an identification code (7:15-16), entry apparatus (6:6-18, refs. 15-16), and transmitter (18, 9), a receiver (4, 7, 8, 27) for receiving id. code and wagering information (15:16-24), the receiver polling the wireless gaming device (7:30-8:5, 15:16-24) to determine whether the player has entered wagering data to be transmitted. Further, Woodfield discloses a microprocessor (17) configured to receive wager information entered by player (15:16-24), digitally store id code (2:4-9, 7:15-19) and transmit the id code and wager information (sic), but lacks 'encrypt' and 'decrypt', (claims 1, 21, 27-28, 39). Woodfield discloses direct switching but this does not teach away from encrypting code and information at

least due to need to protect transmitted data from interception to prevent cheating or identity theft as known in gaming and protection of personal information. Specifically, Franchi discloses a remote wireless terminal teaching a processor configured to encrypt/decrypt the identification and wagering information for transmission/receipt (5:57-63, 6:37-52; 19:59-62) so as to prevent others from tapping into the gaming computer during play so as to prevent hackers from influencing play and outcome of the game in progress (6:45-52). Franchi is relevant prior art to for relating either to wireless gaming or to the particular problem with which applicant was concerned for encrypting and decrypting of transmitted data to ensure integrity thereof in wireless gaming. Alternatively, Koza discloses a wireless lottery ticket teaching a processor that encrypts or decrypts (6:5-8, 17:12-15) to ensure integrity. Therefore, it would have been obvious to an artisan at a time prior to the invention to add encrypt or decrypt as claimed, as taught by either Franchi or Koza to Woodfield to ensure integrity of game.

Woodfield discloses an interactive system, method and apparatus (supra), but also lacks discussing smart card reader (clms 10, 33), account balance register (clm 12), programmable read only memory for storing an identifier (clm 19).

Franchi discloses a system using a wireless gaming device in communication with central computer teaching a smart card reader (5:50-7:15, 18:4-20), account balance register (18:4-20) as balance on smart card, processing 'based on the identification code' (5:50-6:52, 15:26-16:54, 17:51-19:21, 59-62) by verifying account balance, a database for storing an account of the player (5:50-6:52).

Alternatively, Koza discloses a ticket apparatus with transmitter teaching a smart card reader (13:35-39), wager amount register (13:35-39), account balance register (13:35-39), radio

(15:9-24), programmable read only memory for storing an identifier (13:35-39 or 15:62-64), encryption key to encrypt the identification code and the wagering information prior to transmission and to decrypt the identification code and wagering information after being received by receiver (17:12-15) and encrypting the identification code and wagering information prior to transmission (supra). Koza discloses using portable memory devices such as smart cards and thus inherently includes a reader and where such memory devices include registers for storing account balance and memory such as eeprom for storing a player identifier as known in the art. Therefore, it would have been obvious to an artisan at a time prior to the invention to add a smart card reader, wager amount register, account balance register, radio frequency signals, programmable read only memory for storing an identifier, encryption key to encrypt the identification code and the wagering information prior to transmission and to decrypt the identification code and wagering information after being received by receiver and encrypting the identification code and wagering information prior to transmission as taught or suggested by Koza to Woodfield's system to permit remote financial transactions and to not require line of sight transmissions and to increase security of transmissions.

Regarding binary and hexadecimal, Woodfield id code is translated/processed as machine language and thus the code is binary. A hexadecimal code fails to patentably distinguish over Woodfield identification code in so far as whether the code is base 16 or base 2 fails to patentably distinguish since the claimed forms of code are obvious equivalent forms of a code that are merely computer represented in a different base.

Regarding wireless device transmitting signal by radio, Woodfield transmits wagering data upon being polled by receiver (sic) where transmission is by infrared and further the local

receiver transmits by radio. Alternatively, Woodfield wireless device lacks radio. Franchi discloses wireless wagering device (RSAT) as an equivalent from of transmitting data (18:51-55) so as to not require line of sight or not be blocked by intervening obstacles. Further, Koza teaches use of radio (supra). Therefore, it would have been obvious to an artisan at a time prior to the invention to add radio as taught by either Franchi or Koza to Woodfield to not require line of sight and not be blocked by intervening obstacles.

Regarding register, Woodfield processor includes register as ram or rom to store data prior to polled for transmission (7:15-8:22, 15:16-24) and thus inherently includes wager amount register for wagering embodiment to temporarily store wager information until polled. MPEP 2131.02. Alternatively, as stated above, Franchi or Koza include use of register, as claimed, thus, the combination suggests claimed invention (sic).

5. Claims 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodfield in view of either Franchi or Koza as applied to claims 1 or 28 above, and further in view of Jacobsen. Woodfield in view of either Franchi or Koza suggests claimed system or method (sic) except a security tag and sensing apparatus, as claimed. Jacobsen discloses a wireless handheld game device that is used for placing wagers teaching a security tag affixed to or included as part of wireless terminal and a sensing apparatus which activates an alarm when the security tag is passed through the sensing apparatus for increased security to ensure terminal/device does not leave gaming hall. Jacobsen is analogous prior art since Jacobsen is either in the field of applicant's endeavor of wireless wagering handheld device (fig 1-4, ref 20, 96 and description thereof) or, at least is reasonably pertinent to the particular problem with which the applicant was concerned of improved security by adding electronic tag to device/terminal to alert security if

wireless wagering device passes through portal (fig. 4), so as to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Therefore, it would have been obvious to an artisan at a time prior to the invention to add a security tag affixed to or included as part of wireless terminal and a sensing apparatus which activates an alarm when the security tag is passed through the sensing apparatus as taught by Jacobsen to Woodfield in view of either Franchi or Koza for increased security to alert security whenever terminal/device is in process of leaving gaming hall.

Response to Arguments

6. Applicant's arguments filed 4/18/06 have been fully considered but they are not persuasive. Regarding judicially created obviousness double patenting, the amendment does not render holding moot in so far as the claimed invention is maintained as obvious/equivalent form of patented invention (sic). Regarding Applicants assertion that Woodfield does not teach every element, the examiner respectfully disagrees with Applicants reading of Woodfield. In regards to Woodfield lacking a transmitter that transmits wager information or lacking a transmitter that transmits wager information and identification codes, Woodfield states wireless device having an identification code (7:15-8:22) in use in gaming (6:51-8:22) and for specifically, wagering of various sporting events which when taken as a whole at a time prior to the invention suggests to an artisan to include transmitting id code and wagering information such as various forms of horse racing bets (trifecta, etc) or sporting events like collegiate/professional football, baseball, hockey, basketball or any other sport [spread] wager (15:16-24). Applicant is reminded that an inventor only must disclose/teach that which is new and need not disclose within written specification that which is well known to an artisan and preferably omits that which is well

known. Such is the case for Woodfield. Woodfield discloses a wireless terminal and provides examples of environments of use to include gaming, polls and placing of bets on sporting events. Upon an artisan reviewing Woodfield, taken as a whole at a time prior to the invention, an artisan would understand that Woodfield teaches a transmitter transmitting wagering information and identification code upon the wireless terminal being polled for placing a sport wager (sic). Additionally in response to applicant's argument that the Woodfield reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., transmitter transmits wager information together with identification code) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim language is not so limiting as to require transmission of id code and wagering information together in that the claimed code and information can be transmitted separately in that there is no temporal requirement stated in claim. However, Woodfield discloses a transmitter transmitting id code and wagering data, as claimed (supra).

7. Applicant's arguments with respect to claims 1-13, 15-44 has been considered but is moot in view of the new ground(s) of rejection. Encrypting/decrypting wagering information and identification code is deemed obvious to add to Woodfield as suggested/taught by either Franchi or Koza (supra) for increased security to protect against fraud or to protect against identity theft.

Conclusion

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on 571-272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. A. Sager
Primary Examiner
Art Unit 3712

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